

REMARKS

Claims 1-6 and 8-9 are pending in the present application. Claim 7 has been canceled and its limitations have been incorporated in amended independent claim 1. non-elected claims 10-13 have been canceled.

Claims 1, 3-5, 8 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,314,478 ("Oka"). This rejection is respectfully traversed.

The claimed invention relates to a method of osteochondral repair. As such, amended independent claim 1 recites a "method of osteochondral repair" by "creating a recipient socket in bone having an articular surface to be repaired" and "selecting an implant from a set of implants . . . comprising a plurality of preformed implants having different curvatures and contours, each of the implants of the set comprising a cylindrical plug having opposing ends, each end being provided with a surface having a curvature different from the surface at the opposite end of the implant." Amended independent claim 1 also recites "inserting the implant into the recipient socket."

Oka relates to a "prosthesis used for a damaged bone, an artificial articular cartilage or an artificial intervertebral disc being characterized in that the prosthesis is a composite body comprising polyvinyl alcohol hydrogel and ceramic or metallic porous body." (Abstract). According to Oka, "[w]ith this prosthesis, PVA hydrogel enhances lubrication and shock absorbing functions, and the porous body allows the ingrowth and ossification of the bone tissue of a living body therein to affinitively connect said hydrogel to the bones of the living body." (Abstract).

Oka fails to anticipate the subject matter of claims 1, 3-5, 8 and 9. Oka does not disclose, teach or suggest a "selecting an implant from a set containing a plurality of

preformed implants,” as amended independent claim 1 recites. Oka teaches an “artificial articular cartilage” wherein “the PVA hydrogel functions as the articular cartilage of the living body, and the porous alumina ceramics or titanium mesh assures connection and fixation between the tissue of the living body and the PVA hydrogel” (col. 4, ll. 28-33), and not a “plurality of preformed implants” or the step of selecting an implant from a plurality of preformed implants, as in the claimed invention.

Oka further fails to disclose an implant comprising “a cylindrical plug having opposing ends, each end being provided with a surface, each surface having a different curvature from the surface at the opposing end of the implant,” as in the claimed invention. For at least the reasons above, Oka does not anticipate the subject matter of claims 1, 3-5, 8 and 9, and withdrawal of the rejection of these claims is respectfully requested.

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Oka. This rejection is respectfully traversed.

Claim 6 depends on amended independent claim 1 and recites the step of “loading the implant into a delivery tube and delivering the implant by hand into the recipient socket.”

The subject matter of claim 6 would not have been obvious over Oka. Specifically, the Office Action fails to establish a *prima facie* case of obviousness. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, either in the references themselves or in the knowledge of a person of ordinary skill in the art, to modify the reference or combine the reference teachings; (ii) a reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. See

e.g., In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573 (Fed. Cir. 1996).

In the present case, Oka does not disclose, teach or suggest all limitations of amended independent claim 1 and of dependent claim 6. As noted above, Oka is silent about selecting an implant from a set of implants . . . comprising a plurality of preformed implants, the implant comprising a cylindrical plug having opposing ends, each end being provided with a surface, each surface having a different curvature from the surface at the opposing end of the implant, as amended independent claim 1 recites. The crux of Oka is the formation of a prosthesis that has a composite body comprising polyvinyl alcohol hydrogel and ceramic or metallic porous body, and not the specific steps of osteochondral repair of the claimed invention. For at least these reasons, the Office Action fails to establish a *prima facie* case of obviousness and withdrawal of the rejection of claim 6 is respectfully requested.

Claims 1 and 8 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,488,033 ("Cerundolo"). This rejection is respectfully traversed.

Cerundolo relates to surgical techniques "provided whereby a plug from an osteochondral allograft may be transplanted to a cavity site which remains after a condylar defect is removed from a patient's condyle." (Abstract). According to Cerundolo, "the present invention essentially includes placing an osteochondral allograft in substantially the same orientation as the patient condyle, and then removing the transplantable plug therefrom and forming the cavity site in the patient condyle while maintaining their relative same orientation." (Abstract). "In this manner, the surface of the transplanted plug is matched to the contour of the excised osteochondral tissue." (Abstract).

Cerundolo does not anticipate the subject matter of claims 1 and 8.

Cerundolo fails to disclose "selecting an implant from a set of implants . . . comprising a plurality of preformed implants," where each implant of the set comprises "a cylindrical plug having opposing ends, each end being provided with a surface, each surface having a different curvature from the surface at the opposing end of the implant," as amended independent claim 1 recites. Cerundolo teaches an osteochondral transplant technique wherein allografts are transplanted to match exactly the contour of excised osteochondral tissue, and not "selecting an implant from a set of implants . . . comprising a plurality of preformed implants," where each implant of the set comprises "a cylindrical plug having opposing ends, each end being provided with a surface, each surface having a different curvature from the surface at the opposing end of the implant." For at least the reasons above, Cerundolo does not anticipate the subject matter of claims 1 and 8, and withdrawal of the rejection of these claims is respectfully requested.

Claims 1, 4, 6, 8 and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Appl. Pub. No. 2001/0039455 ("Simon"). This rejection is respectfully traversed.

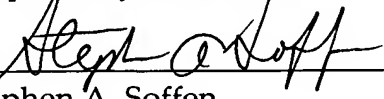
Simon relates to a "cartilage plug, which is made from a biocompatible, artificial material, that is used to fill a void in natural cartilage that has been resected due to traumatic injury or chronic disease." (Abstract). According to Simon, "[t]he plug is prefabricatable in any size, shape, and contour and may be utilized either singly or in a plurality to fill any size void for any application." (Abstract). Simon also teaches that "[t]he plug may be formed of a laminated structure to match the physiological requirements of the repair site" and that "[a] plurality of anchoring elements may share a single upper layer." (Abstract).

Simon does not anticipate the subject matter of claims 1, 4, 6, 8 and 9. Simon fails to disclose "selecting an implant from a set of implants . . . comprising a plurality of preformed implants," where each implant of the set comprises "a cylindrical plug having opposing ends, each end being provided with a surface, each surface having a different curvature from the surface at the opposing end of the implant," as amended independent claim 1 recites. Simon teaches a laminated plug formed of three or more layers, which is used to fill a void in cartilage, and not the specific steps of the claimed invention. Simon also teaches that a "plurality of cartilage plugs are used to fill larger void in what is known as a mosaicplasty." (§[0108]) However, Simon does not disclose, teach or suggest "selecting an implant from a set of implants . . . comprising a plurality of preformed implants," where each implant of the set comprises "a cylindrical plug having opposing ends, each end being provided with a surface, each surface having a different curvature from the surface at the opposing end of the implant," as in the claimed invention. For at least the reasons above, Simon does not anticipate the subject matter of claims 1, 4, 6, 8 and 9, and withdrawal of the rejection of these claims is respectfully requested.

Allowance of all pending claims is solicited.

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Respectfully submitted,

By 
Stephen A. Soffen

Registration No.: 31,063

Gabriela I. Coman

Registration No.: 50,515

DICKSTEIN SHAPIRO LLP

1825 Eye Street, NW

Washington, DC 20006-5403

(202) 420-2200

Attorneys for Applicants